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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Vincent Armentano

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12/15/2006

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EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/084,326	ARMENTANO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Luke Gilligan	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

1. Applicant's election without traverse of claims 1-12 in the reply filed on 9/26/06 is acknowledged.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6 and 12 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 6 and 12 recite the phrase "determine whether there is an indication of anticipated surgery and/or and indication of surgery already performed on the reported claim." It is unclear whether the claim requires the determination of both an indication of anticipated surgery and surgery already performed or whether the determination is only required to be performed in the alternative. For examination purposes, the Examiner will treat the term "and/or" as "or."

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over National Underwriter, AIG tackles claims management (paragraphs numbered by Examiner, hereinafter AIG) in view of Larkin et al, U.S. Patent Application Publication No. 2002/0069089.

7. As per claim 1, AIG discloses a method for providing medical assignments to medical insurance claims, comprising: reporting a medical insurance claim to a claim service office (see paragraph 3); assigning the reported claim to a human claim handler at the claim service office for the claim handler to collect data relating to the reported claim (see paragraph 9); forwarding the reported claim and the collected data to a medical assignment logic (see paragraph 4); automatically performing assignment logic on the reported claim and the collected data to determine whether assignment to case management is warranted (see paragraph 4); if the assignment is warranted, automatically forwarding the reported claim and the collected data to an integrated case management system (see paragraphs 4-7); and if the medical assignment is not warranted, preventing the reported claim and data from reaching the ICMS (see paragraphs 4-7).

8. AIG does not explicitly teach that the assignment logic is a medical assignment logic and that it is determined if medical assignment is warranted for the reported claim. Larkin teaches case management method for workplace injuries in which medical assignment is performed on a reported claim to determine what type of medical assignment is warranted (see paragraphs 0044-0046, 0048, and 0052). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the medical assignment logic into the system disclosed by AIG. One of ordinary skill in the art would have been motivated to incorporate such functionality for the purpose of facilitating case management provider compliance with governmental reporting requirements (see paragraph 0022 of Larkin).

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9. As per claim 2, AIG in view of Larkin teaches the method of claim 1 as described above. AIG further discloses the medical insurance claim is reported from a telephone reporting center to the claim service office via a claim management system (see paragraph 9).

10. As per claim 3, AIG in view of Larkin teaches the method of claim 1 as described above. Although AIG disclose that the system profiles incoming claims using the IDM program, it does not explicitly disclose how the profiling is derived. Larkin further teaches the medical assignment logic is derived by analyzing previous claims that are similar to the reported claim and their medical assignment (see paragraph 0046, the Examiner takes the position that since the medical assignment can be specifically tied to the work environment and "the case management system is used in conjunction with subscribers who manufacture or use...", the medical assignment logic is related to previous "similar" claims to the reported claim). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such functionality into the system disclosed by AIG for the reasons given above with respect to claim 1.

11. As per claim 4, AIG in view of Larkin teaches the method of claim 3 as described above. As described above, AIG does not explicitly disclose how the profiling is derived. Larkin further teaches preparing a list of data elements relating to the previous similar claims, capturing the data elements from the prepared list, and determining when at least one of the captured data elements is populated (see paragraph 0046). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such functionality into the system disclosed by AIG for the reasons given above with respect to claim 1.

12. As per claim 5, AIG in view of Larkin teaches the method of claim 1 as described above. AIG does not explicitly disclose the additional recited steps directed to performing the assignment logic. Larkin further teaches preparing a main list of combinations of a plurality of

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nature of injury data and a plurality of part of body data on which the plurality of NOI are associated (see paragraphs 0042); selecting from the main list a sub-list having combinations of one of the plurality of NOI and an associated one of the plurality of POB that desire medical assignment (see paragraph 0052); comparing the reported claim and the collected data with the sub-list of the combinations of NOI-POB (see paragraph 0046); and determining that the medical assignment is warranted when the reported claim and the collected data match with the sub-list of combinations of NOI/POB (see paragraph 0046). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such functionality into the system disclosed by AIG for the reasons given above with respect to claim 1.

13. As per claim 6, AIG in view of Larkin teaches the method of claim 1 as described above. AIG does not explicitly disclose the additional recited steps directed to performing the assignment logic. Larkin further teaches assessing the reported claim and the collected data to determine whether there is an indication of anticipated surgery or an indication of surgery already performed on the reported claim (see paragraph 0048); and determining that the medical assignment is warranted when there is the indication of anticipated surgery or the indication of surgery already performed on the reported claim (see paragraph 0048). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such functionality into the system disclosed by AIG for the reasons given above with respect to claim 1.

14. As per claim 7, AIG in view of Larkin teaches the method of claim 1 as described above. AIG does not explicitly disclose the additional recited steps directed to performing the assignment logic. Larkin further teaches determining whether there is a new date which disability began for the reported claim (see paragraph 0007); and determining that the medical assignment is warranted when there exists the new date which disability began (see paragraph

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0007). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such functionality into the system disclosed by AIG for the reasons given above with respect to claim 1.

15. As per claim 8, AIG in view of Larkin teaches the method of claim 1 as described above. AIG does not explicitly disclose the additional recited steps directed to performing the assignment logic. Larkin further teaches determining whether a sum of disability time is greater than a predetermined value (see paragraph 0010); and determining that the medical assignment is warranted when the sum is greater than the predetermined value (see paragraph 0010). Larkin does not explicitly teach that the predetermined value is a monetary value. However, the Examiner takes official notice that it is old and well known in the art to calculate disability time incurred expressed as a monetary value. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Larkin to express the disability benchmarking in terms of a monetary value. One of ordinary skill in the art would have been motivated to modify Larkin in this way for the purpose of better proactively managing cases by providing additional useful information such as monetary values for the disclosed benchmarking (see paragraph 0006 of Larkin). In addition, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such functionality into the system disclosed by AIG for the reasons given above with respect to claim 1.

16. As per claim 9, AIG in view of Larkin teaches the method of claim 1 as described above. AIG does not explicitly disclose the additional recited steps directed to performing the assignment logic. Larkin further teaches preparing a main list of ICD-9 codes for which the medical assignment is warranted (see paragraphs 0007-0008); determining whether the reported claim and the collected data include one of the ICD-9 codes in the main list of ICD-9 codes (see paragraph 0008); and determining that the medical assignment is warranted when

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the reported claim and the collected data include one of the ICD-9 codes in the main list of ICD-9 codes (see paragraph 0010). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such functionality into the system disclosed by AIG for the reasons given above with respect to claim 1.

17. As per claim 10, AIG in view of Larkin teaches the method of claim 9 as described above. AIG does not explicitly disclose the additional recited steps directed to performing the assignment logic. Larkin further teaches preparing a first sub-list having selected ICD-9 codes which identify claims with significant medical issues that require medical attention (see paragraph 0007); and preparing a second sub-list having ICD-9 codes of early strategic intervention, which denote a desire to medically intervene (See paragraph 0019). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such functionality into the system disclosed by AIG for the reasons given above with respect to claim 1.

18. As per claim 11, AIG in view of Larkin teaches the method of claim 1 as described above. AIG further discloses the reported claim relates to an injury sustained by an individual (see paragraph 3). AIG does not explicitly disclose the additional recited steps directed to performing the assignment logic. Larkin further teaches assessing the reported claim and the collected data to determine whether the injured individual has not returned to work for more than a predetermined period of time after the injury (see paragraph 0018); and determining that the medical assignment is warranted when the injured individual has not returned to work for more than the predetermined period of time after the injury (see paragraph 0018). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such functionality into the system disclosed by AIG for the reasons given above with respect to claim 1.



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19. Claim 12 recites substantially similar additional limitations to those already addressed in claims 6-9 and, as such, is rejected for similar reasons as given above.

**Conclusion**

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Colburn teaches a system for managing a workers compensation program.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

12/11/06

  
C. LUKE GILLIGAN  
Primary PATENT EXAMINER